

Docket No.: 29827/42222
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ulrich Riegel et al.

Application No.: 10/588,671

Confirmation No.: 9953

Filed: August 8, 2006

Art Unit: 1796

For: Postcrosslinking of Water-Absorbing Polymers

Examiner: Roberto Rabago

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated October 7, 2009, applicants are required to elect one of the following groups of claims:

Group I, claims 1-20, directed to a method of making water-absorbing polymer or

Group II, claims 21-26, directed to water absorbing polymer.

Applicants hereby elect the claims of examiner's Group II, namely, claims 21 through 26, inclusive, with traverse, for examination on the merits at this time.

It is submitted that all claims 1-26, should be examined at this time.

According to PCT Rule 13, claims of different categories with common special technical features do *not* lack unity. Also, see Example 1 in PCT Gazette, page 52, Part 2 I (copy enclosed).

In the present invention, the common special technical feature in all claims is water-absorbing polymer beads prepared by the process of claim 1 and having the properties set forth in claims 21-26. There may be a lack of unity only if this common technical feature lacks novelty or is obvious. See PCT Gazette page 49, part 1(a), (copy enclosed).

The examiner merely states that in view of X references in the International Search Report that a lack of unity exists. However, unity of invention in the present application is evidenced by the International Search Report. In particular, *all* claims were searched, as recited in the Office Action. The standards regarding unity of invention that apply to the International Searching Authority *also* apply to the U.S. Patent Office with respect to this application. Therefore, the unity of invention requirement is fulfilled, and any reliance upon independence or distinctness of the invention is not relevant under the PCT.

In addition, M.P.E.P. §1893.03(d) provides that when making a lack of unity of invention requirement, the examiner *must* "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." A group of inventions is considered linked as to form a single general inventive concept when a technical relationship exists among the inventions that involves at least one common or corresponding special technical feature. That common special technical feature is present in *all* of claims 1-26.

The examiner has not provided *proper* reasons why each group lacks unity with each other group specifically describing the unique special technical feature in each group as required in M.P.E.P. §1893.03(d). The examiner has considered the type of claims, i.e., process for producing a water-absorbent and water-absorbing polymer, without considering the special technical features recited in, and common to, each claim.

The groups do not lack unity of invention with each other. The process and polymer recited in Group I and Group II do not lack unity because Group I recites a process for preparing a water-absorbing polymer and Group II recites a polymer made by that process. Therefore, for all the reasons set forth above, Groups I and II have a unity of invention.

The Office Action fails to indicate whether Groups I and II are classified in different classes or subclasses, but, even if differently classified, the inventions are not independent for the reasons set forth above *and* because the polymer set forth in claims 21-26, and the process set forth in claims 1-20, are so closely related that a search for applicants' process claims would necessarily encompass a search for applicants' polymer claims.

Therefore, even if unity of invention arguably is lacking, no evidence exists that a search and examination directed to all claims would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required.")

Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute the process and product by process claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office to prosecute the process and polymer claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office and applicants to do so in separate applications. Accordingly, it is submitted that all claims should be examined at this time.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. An early action of the merits on all claims is solicited.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Dated: November 3, 2009

Respectfully submitted,

By 

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